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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,522	06/04/2001	Hideyuki Sakamoto	NEC01P072-TSe	3317

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 and 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: A-J as enclosed by the circles in Figures 2-6.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1 and 9 are objected to because of the following informalities:

regarding claim 1, "on" in line 6 should be --of-- as the information is not displayed on a commodity, --trial-- should be inserted after "said" in line 11, and "the user" in line 8 should be --an user--; and,

regarding claim 9, the recitation "said terminal" in line 5 does not agree with the "plurality of terminals" recited in line 2; therefore, "said terminal" in line 5 should read --one of said terminals--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 9, the recitations "means for determining" in line 8, "means for performing ... the purchase procedure" in lines 10-11, and "means for notifying the user ... that the trial purchase procedure cannot be provided" in lines 12-13 are not found in the disclosure. These means are not found in the drawings to render what the means are in the system.

Regarding claims 10-22, the claims depend from claim 9 and therefore contain subject matter not described in the specification.

Claims 9-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Regarding claim 9, applicant has stated three different means for performing actions without specifying what exactly is performing the actions. The question is, what exactly are the means? For instance, the recitation "means for determining whether or not the user has already performed a trial purchase procedure" does not allow one of ordinary skill in the art to associate the means to structure. Is the means a person doing the determination? Furthermore, the recitation "means for performing the purchase procedure" does not enable one to make a structure for performing the purchase procedure. In the same manner, the recitation "means for notifying the user ... that the trial purchase procedure cannot be made" does not enable one skilled in the art to make the means. The specification does not state how to make these means or what they are.

Regarding claims 10-22, the claims depend from claim 9 and therefore do not comply with the enablement requirement.

Art Unit: 3679

Claims 2, 3, 4, 6-8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 3, the limitation "previously" in line 3 makes unclear before what step is storing the destination occurring.

Regarding claim 6, the claim depends from claim 2 and therefore is indefinite.

Regarding claim 4, 7 and 8, the claims depend from claim 3 and therefore are indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Garg et al., 6,571,216.

Regarding claim 1, Garg et al. disclose, in Figure 2, a method of trial purchase, the method includes:

display information of a commodity (free samples; col. 3, line 37) provided from a commodity providing means (web site) on one terminal (col. 3, lines 24-26; col. 5, lines 60-63); ;

determine whether or not an user has already performed a trial purchase procedure (equipment 206 logs an user profile, and the reward offered at a specific date and time; the equipment 206 also checks whether a trial purchase has been done);

if determination is "no", perform, for the user using the terminal, the trial purchase procedure (it is evident that since no record of a user using the trial purchase for the first time has been made, the user can perform a trial purchase); and,

if determination is "yes", notify the user, at the terminal, that the trial purchase procedure cannot be provided (it is inherit that the trial purchase will not be performed when the agent 103 receives a negative response and so a free sample, "freebies", will not be given; col. 12, lines 24-32).

Regarding claim 2, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get trial purchases); and,

provide the commodity to the destination (it is clear that the freebie or the freebies are delivered to the address).

Regarding claim 3, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get trial purchases),

display the destination on the terminals when the commodity is specified on the terminal (it is known to display a delivery address on a terminal by either a confirmation page); and,

designate the destination as a destination of the commodity.

Regarding claims 5-7, the commodity (free samples, "freebies" are free of charge) is free of charge.

Regarding claims 9-22 and 33, given the method described by Garg et al., above, the trial purchase system is inherently constructed.

Regarding claim 9, Garg et al. disclose a trial purchase system comprising terminals **104₁**, **104₂**, a commodity providing means (a web site), a network (an internet), a means for determining whether or not an user has already performed a trial purchase procedure (software that checks database **207**, a means for performing (a mouse) for the user using one terminal, if determination is "no", the purchase procedure, and means for notifying (a modem) the user at the terminal, if the determination is "yes", the trial purchase procedure cannot be provided.

Regarding claim 10, the commodity providing means includes means (it is well known that databases serve to store commodity information, customer information, etc.) for previously storing the destination and providing the commodity to the destination when the commodity is specified on the terminal.

Regarding claim 11, the commodity providing means includes means for previously storing the destination and providing the commodity to a new designated destination when the commodity is specified on the terminal and the new destination is designated therefor.

Regarding claim 12, the commodity providing means includes means **207** for storing the new designated destination (**207**).

Regarding claims 13-15, the system further includes customer information storing means **207** for storing information on the destinations.

Regarding claims 16-22, the system further comprises commodity information storing means (hard drive). The commodity information storing means is for storing information on the commodity.

Regarding claim 33, the commodity providing means includes means (it is well known that servers server to deliver software goods to a customer) for providing said commodity for trial purchase at no charge.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garg et al., 6,571,216, in view of startsampling.com's publication.

Regarding claim 4, Garg et al. do not disclose the method further includes:
storing a newly designated destination as there is no indication that Garg et al. disclose designating a newly designated destination. Startsampling publication teaches a customer able to update account information, which includes an address change. After a customer updates the new information, the server stores a newly designated destination so that the product gets deliver at the customer's new address. Therefore, a web site wanting to provide customers the ability to update a destination as a step for a customer to upgrade shipping delivery information will be motivated to serve the

Art Unit: 3679

customer's needs. Therefore, as taught by startsampling.com's publication, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store a newly designated destination as a result of a customer wanting to update account information so that the product gets deliver to the right location.

Regarding claim 8, Garg et al. disclose the commodity (free samples, "freebies" are free of charge) is free of charge.

Response to Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Art Unit: 3679

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

May 20, 2004



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